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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/575,369

04/11/2006

Marco Alexander Van Den Berg

GRT/4662-168

9073

23117 7590 11/26/2008  
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EXAMINER

ROBINSON, HOPE A

ART UNIT

PAPER NUMBER

1652

MAIL DATE

DELIVERY MODE

11/26/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/575,369	<b>Applicant(s)</b> VAN DEN BERG, MARCO ALEXANDER	
	<b>Examiner</b> HOPE A. ROBINSON	<b>Art Unit</b> 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.  
     4a) Of the above claim(s) 10-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/18/07;4/11/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Application Status***

1. Applicant's election with traverse of Group I (claims 1-9) is acknowledged. The traversal is on the grounds that all claims are rejoined because applicants claim there is no search burden. This argument is not persuasive as the criteria for lack of unity are whether there is a special technical feature and unity of invention. Search burden is not germane to lack of unity. As the requirement established that unity of invention is lacking, the requirement is made final.

2. Claims 1-26 is pending. Claims 1-9 are under examination. Claims 10-26 are withdrawn from further consideration pursuant to 37 CFR 1.12(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim.

3. The Amendment filed on March 11, 2006 has been received and entered.

### ***Drawing***

4. The drawings filed March 11, 2006 are accepted by the examiner.

***Sequence Compliance***

5. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825; applicant's attention is directed to the final rule making notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). To be in compliance, applicant is required to identify all amino acid sequences of at least 4 L-amino acids and at least 10 nucleotides by a sequence identifier, i.e., "SEQ ID NO:". The specification discloses sequences that have not been identified by a sequence identifier, see for example, page 38, lines 12-13. If these sequences have not been disclosed in the computer readable form of the sequence listing and the paper copy thereof, applicant must provide a computer readable form of the "Sequence Listing" including these sequences, a paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification, and a statement that the content of the paper and computer readable form copies are the same and, where applicable, include no new matter as required by 37 CFR 1.821(e) or 1.821(f) or 1.821(g) or 1.821(b) or 1.825(d). See the attached Notice to Comply with the sequence rules.

***Information Disclosure Statement***

6. The Information Disclosure Statements filed on January 18, 2007 and April 11, 2006 have been received and entered. The references cited on the PTO-1449 Form

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have been considered by the examiner and a copy is attached to the instant Office action. Note that some references were lined through as they are duplicates.

### ***Claim Objection***

7. Claim 3 is objected to because of the following informalities:

Claim 3 is objected to because it the following typographical error appears "claims 1".

Correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolff et al. (U.S. Patent No. 6,262,252, July 17, 2001).

Wolff et al. teach a general method of covalently attaching a label to a target molecule using detectable fluorescent tags (see paragraph 4 and 15). Wolff et al. specifically teach a method for covalently attaching a fluorescent label to a nucleic acid (see claims 1-8 of the patent). Wolff et al. teach cells transfected with a DNA (see paragraph 227). In addition, Wolff et al. teach gene transfer (see paragraph 57). Wolff

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et al. teach means of isolation (see paragraphs 95, 105 and 107). Therefore, the limitations of the claims are met by the reference.

9. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al. (AAPS Pharmsci, 1999, cited on the IDS filed January 18, 2007).

Johnson et al. teach a method for monitoring transfer of DNA during transfection, said method involving labeling a plasmid DNA with fluorescein-12-dUTP, flow cytometric detection and sorting of the fluorescent transfected cells (see pages 1-6). Therefore, the limitations of the claims are met by the reference.

### ***Conclusion***

10. No claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hope A. Robinson whose telephone number is 571-272-0957. The examiner can normally be reached on Monday-Friday from 9:00 a.m. to 6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nashaat Nashed, can be reached at (571) 272-0934.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hope A. Robinson/

Primary Examiner, Art Unit 1652

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